

UNITED STATES DEPARTMENT OF COMMERCE
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/1975, 3,12 10/16/97 ROBINSON

0 71 ROBINSON-OLSON

IN21/1106

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EXAMINER

CONTINUED

ART UNIT

PAPER NUMBER

1724

DATE MAILED:

11/06/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/876,322

Applicant(s)

Robson et al.

Examiner

I. Cinti

Group Art Unit

1724

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on August 25, 1998.
- ☒ This action is **FINAL**.

- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1, 3-6, 8-17, 20-22 and 24 is/are pending in the application.
- ☐ Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1, 3-6, 8-17, 20-22 and 24 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) _____.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____.

Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

Art Unit: 1724

Since Applicants did not check "box 1" on the CONTINUED PROSECUTION APPLICATION (CPA) REQUEST TRANSMITTAL filed August 25, 1998, the unentered amendment filed on May 19, 1997 in parent application Serial No. 08/620,482 has not been entered in this application. Accordingly, claims 1, 3-6, 8-17, 20-22 and 24 are currently pending in this application.

Claims 8 and 9 are again rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regards as the invention. The claims depend from a canceled claim (i.e. claim 7), and are therefore indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 5, 6, 9-13 and 16 are again rejected under 35 U.S.C. § 102(b) as being anticipated by Teng et al. (U.S. Patent No. 3,788,984, hereinafter "Teng '984"). Applicants should note that Teng '984 subjects a lignocellulosic material such as sawdust (col. 3, line 35) or paper (col. 3, lines 39-40) to esterification with acetic anhydride (col. 2, line 61); and since

Art Unit: 1724

this procedure appears to be identical to that used by Applicants to produce their product (see page 3, lines 11 and 29 of the specification), the reference material is deemed to be patentably indistinguishable from the material recited in the claims of this application.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 3, 4, 8, 15, 17 and 22 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Teng '984. The reference discloses the claimed invention with the exception of the weight gain of the treated material (claims 3 and 4), the type of lignocellulosic material employed (claim 8), the type of oil removed (claims 15 and 17), and the physical form (i.e. sheet) of this material (claim 22). However, the exact weight gain of the reference material after treatment, its type and physical form, and the exact type of oil removed are not seen to materially affect the overall results of the recited process or product, or to produce any new and unexpected result; and are

Art Unit: 1724

therefore deemed to be obvious matters of choice, which are insufficient to patentably distinguish the claims.

Claims 14, 20, 21 and 24 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Teng '984 in view of Fahlvik. The primary reference discloses the claimed invention with the exception of the outer covering for the modified plant material. Fahlvik discloses encasing a cellulosic oil absorbent material in a mesh covering. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the modified plant material of the primary reference with the covering of the secondary reference, in order to facilitate handling of this primary reference material.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing

Serial Number: 08/876,322

Page 5

Art Unit: 1724


date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is (703) 308-3840. The examiner can normally be reached on Monday through Thursday from 7:30 AM to 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Jay Woo, can be reached on (703) 308-3793.

The fax phone numbers for this art unit are: (703) 305-3599 for "Official" faxes after Final Rejection; (703) 305-7718 for all other "Official" faxes; and (703) 305-3602 for "Draft" and other "Unofficial" faxes.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0661.


Ivars C. Cintins
Primary Examiner
Art Unit 1724

I. Cintins
November 4, 1998